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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,222	03/06/2002	Robert F. Meyerson	24831-022CIP	1762

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EXAMINER	
DYKE, KERRI M	

ART UNIT	PAPER NUMBER
2667	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/092,222	MEYERSON ET AL.	
	Examiner	Art Unit	
	Kerri M. Dyke	2667	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 March 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/23/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1 element 13, figure 2 elements 21, 35, 246, 248 and figure 3 element 109. As there are many drawings, please double check them all to ensure all the errors have been found and are corrected. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claim 23 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 16 of copending Application No. 10/097,217. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-20 and 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 and 21 of copending Application No. 10/097,217. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-9 are identical in both applications. Claims 12-20 and 22 of the instant application are identical to claims 11-19 and 21 of the copending application. The only differences are introduced in the independent claims 1 and 11 of the instant application and 1 and 10 of the copending application. Claims 1 and 10 of the copending application contain all the limitations of claims 1 and 11 from the instant application. Claims 1 and 10 also include limitations that specify a specific type of multimedia device. Thus claims 1 and 10 of the copending application are simply a narrower version of claims 1 and 11 of the instant

application. Claim 10 of the instant application includes an inherent limitation that is presented in claim 1 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyerson et al. (US 5,579,487) in view of Kamo et al. (US 5,610,918).

8. In regards to claim 1, Meyerson discloses a multi-media communication device for serving a selected one of a plurality of data appliance modules, the multi-media communication device comprising:

a. a network communication circuit coupled to a network medium for exchanging frames of data over the network medium;

b. a docking bay for coupling to a selected data appliance module;

c. a data appliance module communication circuit coupled to the docking bay for exchanging data with the selected data appliance module;

d. a data appliance module support circuit comprising:

i. means for reading a network address of a service provider stored in at least one of the multi-media communication device and the selected data appliance module;

ii. means for directing the network communication circuit to establish a communication session with the service provider (figures 1, 4, and 11).

Column 11 lines 48-53 disclose that conventional techniques, which include reading a network address and establishing a communication session, are used.

Meyerson does not disclose means for translating a frame of data originated by the service provider to a signal compatible with transmission to the data appliance module by the data appliance module communication circuit.

Kamo discloses several different embodiments for translating a frame of data.

It would have been obvious to one of ordinary skill in the art to add Kamo's frame translation to Meyerson's communication device because doing so allows for a variable length frame to be exchanged at high speed in a fixed length cell handling exchange network, as disclosed by Kamo in column 3 lines 7-11.

9. In regards to claim 2, Meyerson and Kamo disclose the multi-media communication device of claim 1, wherein the means for translating a frame of data originated by the service provider to a signal compatible with transmission to the data appliance module by the data appliance module communication circuit comprises: means for extracting a value of a data element from the frame of data; means for associating the value with a data element; and means for generating a signal that identifies the data element and the value (Kamo figure 15; column 3 lines 28-43).

10. In regards to claim 3, Meyerson and Kamo disclose the multi-media communication device of claim 1 wherein the means for translating a frame of data originated by the service provider to a signal compatible with transmission to the appliance module by the data appliance module communication circuit comprises: means for extracting a segment of compressed real time media data from the frame of data; and means for generating a signal that includes the segment chronologically sequenced amongst other segments of compressed real time media data. Figure 15 of Kamo discloses translating a frame of data. The information section of the frame can be any type of information and therefore can inherently be compressed real time media data. Kamo also discloses an ATM network, which is well known to include a SYN field for chronological transmission as well as methods for ensuring chronological sequence at the receiver.

11. In regards to claim 4, Meyerson and Kamo disclose the multi-media communication device of claim 1, wherein the data appliance module support circuit further comprises: means for translating a signal received from the data appliance module communication circuit representing subscriber control of the data appliance module to a frame of data compatible with a protocol recognized by the service provider (Kamo figure 10).

12. In regards to claim 5, Meyerson and Kamo disclose the multi-media communication device of claim 4, wherein the means for translating a frame of data originated by the service provider to a signal compatible with transmission to the data appliance module by the data appliance module communication circuit comprises: means for extracting a value of a data element from the frame of data; means for associating the value with a data element; means for generating a signal that identifies the data element and the value; and means for translating a

signal received from the data appliance module communication circuit representing subscriber control of the data appliance module to a frame of data compatible with a protocol recognized by the service provider comprising: means for extracting a value of a data element from the signal; means for extracting identification of the data element from the signal; means for generating a frame that includes the value and the identity of the data element. Figure 9 of Kamo discloses translating a frame from the service provider to the appliance module. Figure 10 of Kamo discloses translating a frame from the appliance module to the service provider. Figure 15 discloses the association between the translated packets.

13. In regards to claim 6, Meyerson and Kamo disclose the multi-media communication device of claim 4, wherein the means for translating a frame of data originated by the service provider to a signal compatible with transmission to the data appliance module by the data appliance module communication circuit comprises: means for extracting a segment of compressed real time media data from the frame of data; means for generating a signal that includes the segment chronologically sequenced amongst other segments of compresses real time media data; and wherein the means for translating a signal received from the data appliance module communication circuit representing subscriber control of the data appliance module to a frame of data compatible with a protocol recognized by the service provider comprises: means for extracting a value of a data element from the signal; means for extracting identification of the data element from the signal; means for generating a frame that includes the value and the identity of the data element. Figure 10 of Kamo discloses translating a frame from the appliance module to the service provider. Figure 15 discloses the association between the translated packets. The information section of the frame can be any type of information and therefore can

inherently be compressed real time media data. Kamo also discloses an ATM network, which is well known to include a SYN field for chronological transmission as well as methods for ensuring chronological sequence at the receiver.

14. In regards to claim 7, Meyerson and Kamo disclose the multi-media communication device of claim 4 further comprising: a subscriber data interface comprising: a display screen, subscriber input means; and a subscriber interface client circuit comprising: means for receiving a signal from the subscriber input means that identifies a remote data source, means for directing the network communication circuit to establishing a communication session with the remote data source, and means for translating data originated by the remote data source to signals compatible for display of the data on the display screen. Meyerson discloses a display screen and input means in figure 3. Figure 11 discloses the circuit for remote data source identification and communication. Kamo discloses translating data originated by the remote source to signals compatible for display in figure 10, where it is disclosed that signals are translated to those appropriate for the end device.

15. Claim 8 is rejected upon the same grounds as claim 5.

16. Claim 9 is rejected upon the same grounds as claim 6.

17. In regards to claim 10, Meyerson and Kamo disclose the multi-media communication device of claim 1 further comprising: power means for providing power to said data appliance module. Providing power is inherently needed in order to use the system, but it is also explicitly disclosed by Meyerson in figure 11 and column 11 lines 41-44.

18. Claims 11-16 are almost identical to claims 1-6. Claims 11-16 replace the term "service provider" found in claims 1-6 with the term "local content server." Claims 11-16 are rejected

upon the same grounds as claims 1-6 because a local content server could be interpreted as being the service provider.

19. Claims 17-23 are identical to claims 1-6 and 10 except for the replacement of "service provider" with "information content server." Claims 17-23 are rejected upon the same grounds as claims 1-6 and 10 because an information content server could be interpreted as being the service provider.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Both Kim et al. and Sakamoto et al. disclose modular systems with protocol translation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kerri M. Dyke whose telephone number is (571) 272-0542. The examiner can normally be reached on Monday through Friday, 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kmd

CHI PHAM
PERVISORY PATENT EXAMIN

12/16/05